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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,080

Applicant(s)

KHOO ET AL.

Examiner

Junior O. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6,16, 24, 32, 51, and 59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6,16, 24, 32, 51, and 59 are an obvious variation of claims 1, 5, 8, and 14, where the reference states that the home shopping programs include infomercials where it is inherent to say that such infomercials are motion pictures.

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Claims 7, 17, 25 and 52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7, 17, 25 and 52 are an obvious variation of claims 2, 8 and 14, where they both comprise the same inventive concept.

Claims 8, 18, 26 and 53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 8, 18, 26 and 53 are an obvious variation of claims 3, 8 and 14, where they both comprise the same inventive concept.

Claims 10, 20, 28 and 55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 10, 20, 28 and 55 are an obvious variation of claim 4, 8 and 14, where they both comprise the same inventive concept.

Claims 11, 21, 29 and 56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11, 21, 29 and 56 are an obvious variation of claims 4, 8 and 14, where they both comprise the same inventive concept.

Claims 13, 23, 31 and 58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13, 23, 31 and 58 are an obvious variation of claims 8 and 14, where they both comprise the same inventive concept.

Claims 14, 33 and 60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 33 and 60 are an obvious variation of claim 1, 8 and 14, where they both comprise the same inventive concept.

Claims 15, 34 and 61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8 and 14 of U.S. Patent No. 6,735,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 15, 34 and 61 are an obvious variation of claims 1, 8 and 14, where they both comprise the same inventive concept.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 6 - 9, 16 - 19 and 24 - 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Smolen (Patent No 5,915,243). Hereinafter referenced as Smolen.

Regarding **claim 6**, Smolen discloses an apparatus for delivering promotions (advertisements or commercials, column 7 lines 58-65) to a person or household, column 2 lines 51-54, moreover he discloses that the signal tuning device (101) displays the promotions on the television (103), column 6 lines 35-37, which reads on "motion picture home shopping programs". Smolen discloses a group of question that are presented to each consumer where their answers create or update their profiles, where said answers are then received by the profile database (140), column 2 lines 66-67 and column 4 lines 55-58 also exhibited on fig 1 and 2, which reads on "receiving personalized data from the viewer". Moreover, Smolen discloses that the answers provided by the consumer are applied to generate an information profile, which contains demographic information that is used for targeting promotions by filtering the information for selected marketing criteria, column 2 lines 66-67 and column 3 lines 1-4, which

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reads on "generating a home shopping program list that identifies a plurality of motion picture home shopping programs related to the personalized data". Moreover, Smolen discloses that the processing facility (130) transmits the promotions to the signal tuning device (101) which is connected to a display device (103), column 6 lines 14-18, which reads on "transmitting a motion picture home shopping program identified in the home shopping program list to the viewer". Moreover, Smolen discloses that such promotions may be immediately offered to the person or household or it might be offered to them at a later time, column 3 lines 6-8, which reads on "for immediate available viewing independent of a broadcast schedule".

Regarding **claim 7**, Smolen discloses a processing facility (30) that implements a neutral network type system that takes the information profile as an input, column 5 lines 62-65 also exhibited on fig 1, which reads on "the receiving of the personalized data includes receiving the personalized data from the viewer over a data network".

Regarding **claim 8**, Smolen discloses that as a part of the questionnaire for the consumer, they are asked to provide their gender, column 5 lines 43-47, which reads on "personalized data comprises gender". Moreover, Smolen discloses that the questions are used to establish potential and current interests that the consumer might have, where the promotions for such interest are then delivered to the consumer, column 3 line 10-15, which reads on "personalized data comprises interests, or any combination of two or more (personal data) thereof".

Regarding **claim 9**, Smolen discloses a preferred method that encourages users at remote locations to take part in surveys designed to profile their preferences as consumers, which creates a unique profile based on everyone's specific characteristics, column 7 lines 38-45; moreover, Smolen discloses a signal tuning device (101), which may be a set top box, is connected to a television (103) and a broadcast system (120), where it is inherent that the term consumer in this reference also refers to a viewer, column 3 lines 45-49 also inherited on fig 1, which reads on "wherein the personalized data comprises data relating to the viewer or an intended gift recipient, or both".

Regarding **claim 16**, Smolen discloses everything claimed. In addition, claim 16 is a variation of claim 6. Therefore, claim 16 stands rejected for the same reasons as stated above (see claim 6) since it is inherent to the method claimed in claim 6.

Regarding **claim 17**, Smolen discloses everything claimed. In addition, claim 17 is a variation of claim 7. Therefore, claim 17 stands rejected for the same reasons as stated above (see claim 7) since it is inherent to the method claimed in claim 7.

Regarding **claim 18**, Smolen discloses everything claimed. In addition, claim 18 is a variation of claim 8. Therefore, claim 18 stands rejected for the same reasons as stated above (see claim 8) since it is inherent to the method claimed in claim 8.

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Regarding **claim 19**, Smolen discloses everything claimed. In addition, claim 19 is a variation of claim 9. Therefore, claim 19 stands rejected for the same reasons as stated above (see claim 9) since it is inherent to the method claimed in claim 9.

Regarding **claim 24**, Smolen discloses everything claimed. In addition, claim 24 is a variation of claim 6. Further, Smolen discloses a bidirectional processing facility (130) connected to the broadcast system (120), column 3 lines 59-63 also exhibited on fig 1, where is well known in the art that a server is a computer that delivers information to other devices as shown on fig 1, which reads on "transmitting data over a client associated with the viewer to a server". Further, Smolen discloses a display (103), column 3 lines 46-48 also exhibited on fig 1, which reads on "displaying the home shopping on a display of the client". Therefore, claim 24 stands rejected for the same reasons as stated above (see claim 6) since it is inherent to the method claimed in claim 6.

Regarding **claim 25**, Smolen discloses everything claimed. In addition, claim 25 is a variation of claims 7 and 24. Therefore, claim 25 stands rejected for the same reasons as stated above (see claims 7 and 24) since it is inherent to the method claimed in claims 7 and 24, respectively.

Regarding **claim 26**, Smolen discloses everything claimed. In addition, claim 26 is a variation of claims 8 and 24. Therefore, claim 26 stands rejected for the same

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reasons as stated above (see claims 8 and 24) since it is inherent to the method claimed in 8 and 24, respectively.

Regarding **claim 27**, Smolen discloses everything claimed. In addition, claim 27 is a variation of claims 9 and 24. Therefore, claim 27 stands rejected for the same reasons as stated above (see claims 9 and 24) since it is inherent to the method claimed in claim 9 and 24, respectively.

Regarding **claim 28**, Smolen discloses everything claimed. In addition, claim 28 is a variation of claims 10 and 24. Therefore, claim 28 stands rejected for the same reasons as stated above (see claims 10 and 24) since it is inherent to the method claimed in claims 10 and 24, respectively.

Regarding **claim 29**, Smolen discloses everything claimed. In addition, claim 29 is a variation of claims 11, 24 and 28. Therefore, claim 29 stands rejected for the same reasons as stated above (see claims 11, 24 and 28) since it is inherent to the method claimed in claims 11, 24 and 28, respectively.

Regarding **claim 30**, Smolen discloses everything claimed. In addition, claim 30 is a variation of claims 12 and 24. Therefore, claim 30 stands rejected for the same reasons as stated above (see claims 12 and 24) since it is inherent to the method claimed in claims 12 and 24, respectively.

Regarding **claim 31**, Smolen discloses everything claimed. In addition, claim 31 is a variation of claims 13 and 24. Therefore, claim 31 stands rejected for the same reasons as stated above (see claims 13 and 24) since it is inherent to the method claimed in claims 13 and 24, respectively.

Regarding **claim 32**, Smolen discloses everything claimed. In addition, claim 32 is a variation of claim 24. Therefore, claim 32 stands rejected for the same reasons as stated above (see claim 24) since it is inherent to the method claimed in claim 24.

Regarding **claim 33**, Smolen discloses everything claimed. In addition, claim 33 is a variation of claims 14 and 24. Therefore, claim 33 stands rejected for the same reasons as stated above (see claims 14 and 24) since it is inherent to the method claimed in claims 14 and 24, respectively.

Regarding **claim 34**, Smolen discloses everything claimed. In addition, claim 34 is a variation of claims 15, 24 and 33. Therefore, claim 34 stands rejected for the same reasons as stated above (see claims 15, 24 and 33) since it is inherent to the method claimed in claims 15, 24 and 33, respectively.

Regarding **claim 35**, Smolen discloses everything claimed. In addition, claim 35 is a variation of claim 6. Further, Smolen discloses a television (103) that displays a

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prompt requesting a code and password (202), which accesses the users profiles on the profile database (140), column 3 lines 19-22 and lines 55-67 also exhibited on fig 1 and fig 2, which reads on “associating the identifying data with the personal data of the viewer, the personalized data being previously stored or received with the identifying data”. Therefore, claim 35 stands rejected for the same reasons as stated above (see claim 6) since it is inherent to the method claimed in claim 6.

Regarding **claim 36**, Smolen discloses everything claimed. In addition, claim 36 is a variation of claims 8 and 35. Therefore, claim 36 stands rejected for the same reasons as stated above (see claims 8 and 35) since it is inherent to the method claimed in claims 8 and 35, respectively.

Regarding **claim 37**, Smolen discloses everything claimed. In addition, claim 37 is a variation of claims 9 and 35. Therefore, claim 37 stands rejected for the same reasons as stated above (see claims 9 and 35) since it is inherent to the method claimed in claims 9 and 35, respectively.

Regarding **claim 38**, Smolen discloses everything claimed. In addition, claim 38 is a variation of claims 10 and 35. Therefore, claim 38 stands rejected for the same reasons as stated above (see claims 10 and 35) since it is inherent to the method claimed in claims 10 and 35, respectively.

Regarding **claim 39**, Smolen discloses everything claimed. In addition, claim 39 is a variation of claims 11, 35 and 38. Therefore, claim 39 stands rejected for the same reasons as stated above (see claims 11, 35 and 38) since it is inherent to the method claimed in claims 11, 35 and 38, respectively.

Regarding **claim 40**, Smolen discloses everything claimed. In addition, claim 40 is a variation of claims 12 and 35. Therefore, claim 40 stands rejected for the same reasons as stated above (see claims 12 and 35) since it is inherent to the method claimed in claims 12 and 35, respectively.

Regarding **claim 41**, Smolen discloses everything claimed. In addition, claim 41 is a variation of claims 13 and 35. Therefore, claim 41 stands rejected for the same reasons as stated above (see claims 13 and 35) since it is inherent to the method claimed in claims 13 and 35, respectively.

Regarding **claim 42**, Smolen discloses everything claimed. In addition, claim 42 is a variation of claims 14 and 35. Therefore, claim 42 stands rejected for the same reasons as stated above (see claims 14 and 35) since it is inherent to the method claimed in claims 14 and 35, respectively.

Regarding **claim 43**, Smolen discloses everything claimed. In addition, claim 43 is a variation of claims 15, 35 and 42. Therefore, claim 43 stands rejected for the same

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reasons as stated above (see claims 15, 35 and 42) since it is inherent to the method claimed in claims 15, 35 and 42, respectively.

Regarding **claim 44**, Smolen discloses everything claimed. In addition, claim 44 is a variation of claims 6 and 35. Therefore, claim 44 stands rejected for the same reasons as stated above (see claims 6 and 35) since it is inherent to the method claimed in claims 6 and 35, respectively.

Regarding **claim 45**, Smolen discloses everything claimed. In addition, claim 45 is a variation of claims 8 and 35. Therefore, claim 45 stands rejected for the same reasons as stated above (see claims 8 and 35) since it is inherent to the method claimed in claims 8 and 35, respectively.

Regarding **claim 46**, Smolen discloses everything claimed. In addition, claim 46 is a variation of claims 9 and 35. Therefore, claim 46 stands rejected for the same reasons as stated above (see claims 9 and 35) since it is inherent to the method claimed in claims 9 and 35, respectively.

Regarding **claim 47**, Smolen discloses everything claimed. In addition, claim 47 is a variation of claims 10 and 35. Therefore, claim 47 stands rejected for the same reasons as stated above (see claims 10 and 35) since it is inherent to the method claimed in claims 10 and 35, respectively.

Regarding **claim 48**, Smolen discloses everything claimed. In addition, claim 48 is a variation of claims 11 and 35. Therefore, claim 48 stands rejected for the same reasons as stated above (see claims 11 and 35) since it is inherent to the method claimed in claims 11 and 35, respectively.

Regarding **claim 49**, Smolen discloses everything claimed. In addition, claim 49 is a variation of claims 12 and 35. Therefore, claim 49 stands rejected for the same reasons as stated above (see claims 12 and 35) since it is inherent to the method claimed in claims 12 and 35, respectively.

Regarding **claim 50**, Smolen discloses everything claimed. In addition, claim 50 is a variation of claims 13 and 35. Therefore, claim 50 stands rejected for the same reasons as stated above (see claims 13 and 35) since it is inherent to the method claimed in claims 13 and 35, respectively.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 - 12 and 20 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Robertson (Patent No 6,609,106). Hereinafter referenced as Robertson.

Regarding **claim 10**, Smolen discloses everything claimed as applied above (See claim 6), in addition, Smolen discloses a group of question that are presented to each consumer where their answers create or update their profiles, where said answers are then received by the profile database (140), column 2 lines 66-67 and column 4 lines 55-58 also exhibited on fig 1 and 2, which reads on "personalized data". However, Smolen fails to disclose that the personalized data comprises specific items to be purchased or gift occasions, or both. However, the examiner maintains that it was well known in the art to provide personalized data that comprises specific items to be purchased or gift occasions, or both, as taught by Robertson.

In a similar field of endeavor Robertson discloses a System and method for providing electronic multi-merchant gift registry services over a distributed network. In addition, Robertson discloses a system and method that provides a gift registry for all

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occasions, where the consumer can personalize it based on what they might be looking for, column 3 lines 19-20, which reads on "the personalized data comprises specific items to be purchased or gift occasions, or both".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing personalized data that comprises specific items to be purchased or gift occasions, or both, as taught by Robertson, for the purpose of providing the consumer another way of search and resources that allows a fast and effective way to look for the right gift for the right occasion.

Regarding **claim 11**, Smolen discloses everything claimed as applied above (See claim 10), in addition, Smolen discloses a group of question that are presented to each consumer where their answers create or update their profiles, where said answers are then received by the profile database (140), column 2 lines 66-67 and column 4 lines 55-58 also exhibited on fig 1 and 2, which reads on "personalized data (for gift occasions)". However, Smolen fails to disclose that the gift occasions comprise: birthday, mother's day, wedding, anniversary, or baby shower, or a combination of two or more thereof. However, the examiner maintains that it was well known in the art to provide gift occasions that comprise: birthday, mother's day, wedding, anniversary, or baby shower, or a combination of two or more thereof, as taught by Robertson.

In a similar field of endeavor Robertson discloses a System and method for providing electronic multi-merchant gift registry services over a distributed network. In

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addition, Robertson discloses a system that allows notification in advance for yearly events such as mother's day, column 25 lines 22-23; moreover, Robertson discloses that the system applies for all occasions, including bridal events, column 3 lines 19-20, which reads on "gift occasions comprise: birthday, mother's day, wedding, anniversary, or baby shower, or a combination of two or more thereof".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing gift occasions that comprise: birthday, mother's day, wedding, anniversary, or baby shower, or a combination of two or more thereof, as taught by Robertson, for the purpose of providing the consumer another way of search and resources that allows a fast and effective way to look for the right gift for the right occasion, where groups can be formed based on a specific event which is very convenient.

Regarding **claim 12**, Smolen discloses everything claimed as applied above (See claim 6), in addition, Smolen discloses a group of question that are presented to each consumer where their answers create or update their profiles, where said answers are then received by the profile database (140), column 2 lines 66-67 and column 4 lines 55-58 also exhibited on fig 1 and 2, which reads on "personalized data". However, Smolen fails to disclose that the personalized data comprises a price range of an item for purchase. However, the examiner maintains that it was well known in the art to provide personalized data that comprises a price range of an item for purchase, as taught by Robertson.

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In a similar field of endeavor Robertson discloses a System and method for providing electronic multi-merchant gift registry services over a distributed network. In addition, Robertson discloses a system that allows filtering of the items the consumer requested based on price range, column 9 lines 34-37, which reads on "the personalized data comprises a price range of an item for purchase".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing personalized data that comprises a price range of an item for purchase, as taught by Robertson, for the purpose of making groups of advertisements based on the budget of the consumer or based on the amount of money they would like to spend for a given purchase.

Regarding **claim 20**, Smolen and Robertson disclose everything claimed. In addition, claim 20 is a variation of claim 10. Therefore, claim 20 stands rejected for the same reasons as stated above (see claim 10) since it is inherent to the method claimed in claim 10.

Regarding **claim 21**, Smolen and Robertson disclose everything claimed. In addition, claim 21 is a variation of claim 11. Therefore, claim 21 stands rejected for the same reasons as stated above (see claim 11) since it is inherent to the method claimed in claim 11.

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Regarding **claim 22**, Smolen and Robertson disclose everything claimed. In addition, claim 22 is a variation of claim 12. Therefore, claim 22 stands rejected for the same reasons as stated above (see claim 12) since it is inherent to the method claimed in claim 12.

Claim **13-15, 23 and 51-61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Herz et al. (Patent No 6,088,722). Hereinafter referenced as Herz.

Regarding **claim 13**, Smolen discloses everything claimed as applied above (See claim 6), in addition, Smolen discloses an apparatus for delivering promotions (advertisements or commercials) to a person or household, column 2 lines 51-54, moreover he discloses that the signal tuning device (101) displays the promotions on the television (103), column 6 lines 35-37, which reads on "motion picture home shopping programs". However, Smolen fails to disclose that the motion picture home shopping program comprises one or more infomercials, one or more advertisements, or one or more broadcast shopping channels, or any combination thereof. However, the examiner maintains that it was well known in the art to provide motion picture home shopping program that comprises one or more infomercials, one or more advertisements, or one or more broadcast shopping channels, or any combination thereof, as taught by Herz.

In a similar field of endeavor Herz discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profiles. In addition, Herz discloses a system for making available the video programming and other types of data based on the customer's preferences, which may include home shopping selections and infomercials, columns 4 lines 39-48, which reads on "the motion picture home shopping program comprises one or more infomercials, one or more advertisements, or one or more broadcast shopping channels, or any combination thereof".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing motion picture home shopping program that comprises one or more infomercials, one or more advertisements, or one or more broadcast shopping channels, or any combination thereof, as taught by Herz, as taught by Herz, for the purpose of allowing the customer to determine what kind of commercials and infomercial advertisement they would like to be exposed to based on their predilection.

Regarding **claim 14**, Smolen discloses everything claimed as applied above (See claim 6), in addition, Smolen discloses an apparatus for delivering promotions (advertisements or commercials) to a person or household, column 2 lines 51-54, moreover he discloses that the signal tuning device (101) displays the promotions on the television (103), column 6 lines 35-37, which reads on "motion picture home shopping list". However, Smolen fails to disclose the ability of receiving a modified

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version of the home shopping program list from the viewer. However, the examiner maintains that it was well known in the art to provide the ability of receiving a modified version of the home shopping program list from the viewer, as taught by Herz.

In a similar field of endeavor Herz discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profiles. In addition, Herz discloses that one can modify the algorithm to take into account other known determinants related to customer behavior, column 34 lines 58-59, wherein such algorithm is used to determine the broadcasted schedule based on the customer's profile, column 23 lines 40-46, which reads on "receiving a modified version of the home shopping program list from the viewer".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing the ability of receiving a modified version of the home shopping program list from the viewer, as taught by Herz, for the purpose of providing the customer the ability to change his preferences in the future, since one's preferences may change with time.

Regarding **claim 15**, the combination of Smolen and Herz disclose everything claimed as applied above (See claim 14), in addition, Smolen discloses an apparatus for delivering promotions (advertisements or commercials) to a person or household, column 2 lines 51-54, moreover he discloses that the signal tuning device (101) displays the promotions on the television (103), column 6 lines 35-37, which reads on "motion

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picture home shopping list". However, Smolen fails to disclose that the receiving of the modified version of the home shopping program list from the viewer comprises receiving one or more inserted motion picture home shopping programs, one or more removed motion picture home shopping programs or one or more moved motion picture home shopping programs, or any combination thereof. However, the examiner maintains that it was well known in the art to provide the receiving of the modified version of the home shopping program list from the viewer comprising receiving one or more inserted motion picture home shopping programs, one or more removed motion picture home shopping programs or one or more moved motion picture home shopping programs, or any combination thereof, as taught by Herz.

In a similar field of endeavor Herz discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profiles. In addition, Herz discloses that for example the user can remove recently shown movies from the list which has been previously built based on their preferences, columns 28 lines 23-25, where it is inherent that the same can also be done with home shopping programs, which reads on "the receiving of the modified version of the home shopping program list from the viewer comprises receiving one or more inserted motion picture home shopping programs, one or more removed motion picture home shopping programs or one or more moved motion picture home shopping programs, or any combination thereof".

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smolen by specifically providing the receiving of

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the modified version of the home shopping program list from the viewer comprising receiving one or more inserted motion picture home shopping programs, one or more removed motion picture home shopping programs or one or more moved motion picture home shopping programs, or any combination thereof, as taught by Herz, for the purpose of further customizing the home shopping program list, which offers a lot more flexibility to the user.

Regarding **claim 23**, Smolen and Herz disclose everything claimed. In addition, claim 23 is a variation of claim 13. Therefore, claim 23 stands rejected for the same reasons as stated above (see claim 13) since it is inherent to the method claimed in claim 13.

Regarding **claim 51**, Smolen and Herz disclose everything claimed. In addition, claim 51 is a variation of claim 6. Further, Smolen discloses a profile database (140) and a promotions databases (160) for data storage, column 5 lines 31-37 and column 6 lines 6-9 also exhibited on fig 1, which reads on "one or more memories for storing personalized data, home shopping program lists, and home shopping programs". Further, Smolen discloses a processing facility (130), column 5 lines 31-37 also exhibited on fig 1, where it is obvious that such facility would contain a processor to perform its tasks; moreover, Herz discloses a Microprocessor (1102) and a memory (1106) that processes the algorithms necessary to produce the user's list, columns 51 lines 26-34 also exhibited on fig 11, which reads on "one or more processors in

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communication with one or more memories". Therefore, claim 51 stands rejected for the same reasons as stated above (see claim 6) since it is inherent to the method claimed in claim 6.

Regarding **claim 52**, Smolen and Herz disclose everything claimed. In addition, claim 52 is a combination of claims 7 and 51. Therefore, claim 52 stands rejected for the same reasons as stated above (see claims 7 and 51) since they are inherent to the method claimed in claim 7 and 51, respectively.

Regarding **claim 53**, Smolen and Herz disclose everything claimed. In addition, claim 53 is a combination of claims 8 and 51. Therefore, claim 53 stands rejected for the same reasons as stated above (see claims 8 and 51) since they are inherent to the method claimed in claim 8 and 51, respectively.

Regarding **claim 54**, Smolen and Herz disclose everything claimed. In addition, claim 54 is a combination of claims 9 and 51. Therefore, claim 54 stands rejected for the same reasons as stated above (see claims 9 and 51) since they are inherent to the method claimed in claim 9 and 51, respectively.

Regarding **claim 55**, Smolen and Herz disclose everything claimed. In addition, claim 55 is a combination of claims 10 and 51. Therefore, claim 55 stands rejected for

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the same reasons as stated above (see claims 10 and 51) since they are inherent to the method claimed in claim 10 and 51, respectively.

Regarding **claim 56**, Smolen and Herz disclose everything claimed. In addition, claim 56 is a combination of claims 11, 51 and 55. Therefore, claim 56 stands rejected for the same reasons as stated above (see claims 11, 51 and 55) since they are inherent to the method claimed in claim 11, 51 and 55, respectively.

Regarding **claim 57**, Smolen and Herz disclose everything claimed. In addition, claim 57 is a combination of claims 12 and 51. Therefore, claim 57 stands rejected for the same reasons as stated above (see claims 12 and 51) since they are inherent to the method claimed in claim 12 and 51, respectively.

Regarding **claim 58**, Smolen and Herz disclose everything claimed. In addition, claim 58 is a combination of claims 13 and 51. Therefore, claim 58 stands rejected for the same reasons as stated above (see claims 13 and 51) since they are inherent to the method claimed in claim 13 and 51, respectively.

Regarding **claim 59**, Smolen and Herz disclose everything claimed. In addition, claim 59 is a combination of claims 6 and 51. Therefore, claim 59 stands rejected for the same reasons as stated above (see claims 6 and 51) since they are inherent to the method claimed in claim 6 and 51, respectively.

Regarding **claim 60**, Smolen and Herz disclose everything claimed. In addition, claim 60 is a combination of claims 14 and 51. Therefore, claim 60 stands rejected for the same reasons as stated above (see claims 14 and 51) since they are inherent to the method claimed in claim 14 and 51, respectively.

Regarding **claim 61**, Smolen and Herz disclose everything claimed. In addition, claim 61 is a combination of claims 15, 51 and 60. Therefore, claim 61 stands rejected for the same reasons as stated above (see claims 15, 51 and 60) since they are inherent to the method claimed in claim 15, 51 and 60, respectively.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Eldering (Patent No 6,216,129) – Advertisement selection system supporting discretionary target market characteristics.
- Kanevsky et al. (US 6,334,109) – Distributed personalized advertisement system and method.
- Reynolds et al. (Patent No 6,799,327) – Program guide with selectable advertisements and pseudo-ads.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Junior O. Mendoza whose telephone number is 571-270-3573. The examiner can normally be reached on Monday - Thursday 8am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jefferey Harold can be reached on 571-272-7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Junior O Mendoza
Examiner
Art Unit 2609

JM 
September 4, 2007



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SUPERVISORY PATENT EXAMINER